

## REMARKS

In the Office Action dated October 15, 2007, the Office imposed a restriction requirement under 35 U.S.C. §121 against pending claims and required that an election be made between one of the following groups:

- Group I (claims 1-14) drawn to a technical feature of at least two high-mannose oligosaccharide cluster on a scaffolding framework;
- Group II, (claims 15-19) drawn to a technical feature of a method of making a high mannose oligosaccharide cluster;
- Group III (claims 20-24 and 26-29) drawn to a technical feature of a method of inducing HIV neutralizing antibodies and a method of combating HIV infection;
- Group IV (claims 30-33) drawn to a technical feature of a method of detecting candidate compounds that interact with oligomannose sugars on HIV gp120; and
- Group V (claim 34) drawn to a technical feature of an antibody that binds to a high mannose oligosaccharide cluster.

The Office concludes that the requirement for restriction is proper because the claimed inventions are distinct. In response, applicant elects Group I claims 1-14. Such election is WITH TRAVERSE.

The traversal is based on the fact that the stated grounds for the restriction do not comport with the requirements of the 35 USC 121, which requires that:

"[I]f two or more independent and distinct inventions are claimed in one application, the Director may require the application to be restricted to one of the inventions."

The statute therefore requires as a basis for legally permissible restriction that the subject matter of respective claims be both independent and distinct. The Examiner's attention is directed in this respect to the provisions of MPEP Section 802.01 (Meaning of "Independent" and "Distinct"), which states, inter alia:

"The term 'independent' (i.e., not dependent) means that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation, or effect..."

It is apparent from this provision of the MPEP that the subject matter of Groups I, II, III and IV are not "independent" within the meaning of 35 USC 121 in the respective claims, and that therefore the groups are not properly restricted. The implementing regulations of the Patent and Trademark Office include the mandate that restriction is appropriate only in cases presenting inventions which are both independent

and distinct, 37 C.F.R. §§1.141-142. Without independence and distinctness, a restriction requirement is unauthorized.

The courts have recognized that it is in the public interest to permit an applicant to claim related aspects of their invention together in one application, as the applicant has done herein. The CCPA has observed:

We believe the constitutional purpose of the patent system is promoted by encouraging applicants to claim, and therefore to describe in the manner required by 35 U.S.C. §112 all aspects as to what they regard as their invention, regardless of the number of statutory classes involved. In re Kuehl, 456 F.2d 658, 666, 117 U.S.P.Q. 250, 256 (CCPA 1973).

It is vital to all applicants that restriction requirements issue only with the proper statutory authorization, because patents issuing on divisional applications which are filed to prosecute claims that the Examiner held to be independent and distinct can be vulnerable to legal challenges alleging double patenting. The third sentence of 35 U.S.C. §121, which states that a patent issuing on a parent application “shall not be used as a reference” against a divisional application or a patent issued thereon, does not provide comfort to an applicant against such allegations. The Court of Appeals for the Federal Circuit has declined to hold that §121 protects a patentee from an allegation of same-invention double patenting, Studiengesellschaft Kohle mbH v. Northern Petrochemical Co., 784 F.2d 351, 355, 228 U.S.P.Q. 837, 840 (Fed. Cir. 1986); and in Gerber Garment Technology Inc. v. Lectra Systems Inc., 916 F.2d 683, 16 U.S.P.Q. 2d 1436 (Fed. Cir. 1990) that court held that §121 does not insulate a patentee from an allegation of “obviousness-type” double patenting, and in fact affirmed the invalidation on double patenting grounds of a patent that had issued from a divisional application filed following a restriction requirement. Furthermore, it is far from clear that the step of filing a terminal disclaimer is available to resolve a double patenting issue that arises after the issuance of patent on the divisional application.

All these considerations indicate that the imposition of a restriction requirement with inadequate authority can lead to situations in which an applicant’s legitimate patent rights are exposed to uncertainty and even extinguished. Accordingly, to protect a patentee’s rights and to serve the public’s interest, the Examiner should not require restriction where various interrelated aspects of a unitary invention are claimed.

Thus, applicant requests that when the product claims of the present invention are found patentable, all method and use claims be examined through the rejoinder procedure in accordance with MPEP §821.04. When an application as originally filed discloses a product and the process for making and/or using such product, and only the claims directed to the product are presented for examination, when a product claim

is found allowable, applicant may present claims directed to the process of making and/or using the patentable product for examination through rejoinder procedure in accordance with MPEP §821.04, provided that the process claims depend from or include all the limitations of the allowed product claims.

In the present application the product claims 1-14 are directed to a product and the claims recited in Groups II, III and IV are directed to a method for using such product. As such the claims meet the requirements set forth under MPEP §821.04 for rejoinder and thus should be rejoined when the product claims are found patentable.

### **Fees Payable**

Applicant petitions for a one month extension thereby extending the deadline of November 15, 2007 to December 15, 2007. The petition fee of \$60.00 is being paid electronically. If any additional fee is found due, the Commissioner is authorized to charge any deficiencies of payment associated with this Communication, or to credit any overpayment, to **Deposit Account No. 13-4365** of Moore & Van Allen, PLLC.

Respectfully submitted,

MOORE & VAN ALLEN PLLC

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